

**REMARKS**

Claims 1-13 were rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of prior patent 6,183,693. Although the Examiner noted changes in nomenclature between the claims, he concluded that “the specific structure and functional capabilities for the noted elements, as set out in the claims, are identical as between the patented claims and the instant claims. Thus, the instant and patented claims are of identical scope.” That rejection is respectfully traversed and reconsideration is requested.

As discussed in the Manual of Patent Examining Procedure at page 800-20, a “reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent.”

A comparison of the claims as they stand after this amendment with the issued claims of patent 6,183,693 is attached. Deleted portions of the issued claims are crossed-out and added elements of the claims of this application are in red. These amendments are in response to arguments made by a defendant in litigation with respect to the ‘693 patent. In that litigation, the defendant attempted to narrow the claims by arguing narrowed interpretations. The pending claims remove any question as to their broad scope.

Although the defendant generally failed in attempts at obtaining a narrow interpretation, the case is on appeal. Based on the defendant’s interpretation, the pending claims could be infringed without infringing the patent claims.

Following are potentially broadening terms of the pending claims.

Claim 1:

- a. The phrase “random access” is eliminated, broadening the claim.
- b. Changing “heating element sets” to “heating elements” eliminates any possible confusion over the meaning of a “set.”

- c. A broader term “electronic circuitry” replaces “temperature controller,” as the defendant argued that the latter term included certain additional elements that are not stated in the claim. The defendant argued that the term “temperature controller” required that certain functions be on or off of the platform and that a comparator was required. The broader term avoids any such argument. With the change in terminology, it is intended to make clear that the claimed electronic circuitry need only supply variable amounts of electric power to the heating elements and may be either open or closed loop.
- d. The phrase “in communication with a temperature controller and” has been deleted in view of the defendant’s arguments that the phrase implied a temporal limitation, that the communication had to be constantly ongoing during the staining procedure. By removing the phrase, any possible contention in that respect is avoided.

Dependent claims 2-4 are modified to be consistent with independent claim 1.

Dependent claim 5 is broadened so as to not specify which circuit receives the temperature feedback information. The patent specification supports the possibilities that the information is provided to a microprocessor on the moving platform or a microprocessor off of the moving platform, or both.

Dependent claims 6-7 are modified to be consistent with independent base claim 1.

In claim 8, the terms “sets” and “temperature controller” are removed as discussed above. The claim is also more explicit in reciting that the electronic circuitry supplies “electrical power to said heating elements to attain said desired temperature.”

Claim 9 is broadened so as not to specify where the temperature feedback data is sent.

Claim 10:

- a. "Temperature controller" is removed as discussed above. Further, reference to "a plurality" of temperature controller electronic circuits is removed.
- b. The term "computer" is changed to "processor" because the defendant argued that "computer" must mean a free standing personal computer.
- c. The term "link" has been changed to "path" because the defendant argued that a data communication link had to be a direct link. The term "path" makes it clear that intermediate elements could receive the data and, in turn, pass it along.

Claim 12 is broadened so as not to specify the destination of the temperature feedback.

Claim 13 has been amended to remove "random access" and "temperature controller" as discussed above.

From the above discussion, it can be seen that the claims in this application are at least potentially of different scope than those in the issued patent. Accordingly, the claims are sufficiently different as to not claim identical subject matter and the rejection under 35 U.S.C. 101 should be withdrawn.

The attached Terminal Disclaimer should overcome any obviousness double patenting rejection.

New claims 14-17 have been added.

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**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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## WordPerfect Document Compare Summary

Original document: ::ODMA\MHODMA\HBSR05;iManage;167778;1

Revised document: @PFDesktop\::ODMA/MHODMA/HBSR05;iManage;459868;1

Deletions are shown with the following attributes and color:

**Strikeout**, Blue RGB(0,0,255).

Deleted text is shown as full text.

Insertions are shown with the following attributes and color:

**Double Underline**, Redline, Red RGB(255,0,0).

The document was marked with 78 Deletions, 84 Insertions, 0 Moves.

ALLOWED CLAIMS AS AMENDED

What is claimed is:

1. A microscope slide stainer with random access slide staining capability, comprising:
  - a moving platform adapted to support a plurality of microscope slides bearing biologic samples;
  - a plurality of heating element setselements, each set having at least one heating element and each set heating at least one slide, each of saidthe heating element sets havingelements heating the capability of heatingslides to different temperatures;
  - a temperature controllerelectronic circuitry that regulatessupplies variable amounts of electrical power to said heating element setselements, said temperature controllerelectronic circuitry being mounted on the moving platform; and-
  - a user interface in communication with the temperature controller and through which a desired temperatures for microscope slides isare specified, said user interface being mounted off of the moving platform and communicating data to the temperature controllersaid electronic circuitry on the moving platform to regulatecause said electronic circuitry on the moving platform to supply electrical power to thesaid heating element setselements to heat said heating elements to said desired temperatures.
2. A microscope slide stainer as claimed in claim 1, wherein the temperature controller, capable of moving on said electronic circuitry on the moving platform; and the user interface, not mounted on said moving platform, communicate electrically via a group of conductors.
3. A microscope slide stainer as claimed in claim 2, wherein the number of conductors in

the group of conductors is fewer than the number of heating element setselements.

4. A microscope slide stainer as claimed in claim 1, wherein the temperature controller electronic circuitry comprises a shift register, which receives control data from the user interface.
5. A microscope slide stainer as claimed in claim 1, further comprising a temperature sensor for providing temperature feedback information to the temperature controller electronic circuit.
6. A microscope slide stainer as claimed in claim 1 wherein each heating element set heats a single slide.
7. A microscope slide stainer as claimed in claim 1 wherein each heating element set comprises a flat slide support surface.
8. A microscope slide stainer with random access slide staining capability, comprising:
  - a plurality of microscope slides bearing biologic samples, positioned on a moving platform;
  - a plurality of heating element setselements on the moving platform, each set having at least one heating element and each set capable of heating at least one slide, each capable of heating and at least one being heated to a temperature distinct from the temperatures of other heatersheating elements;
  - a temperature controller electronic circuitry that regulates electrical power to said heating element setselements, said temperature controller electronic circuitry being mounted on the moving platform;
  - a user interface through which a desired temperatures for each microscope slides is specified, said user interface being mounted off of the moving platform and said user

interface comprising electronic circuitry which communicates data to the temperature controller electronic circuitry on the moving platform, causing said electronic circuitry on the moving platform to regulate the supply electrical power to the said heating element setelements to attain said desired temperature; and,

a group of conductors; for providing an electrical connection between the temperature controller said electronic circuitry on the moving platform and the user interface, the number of conductors in said group of conductors being less than the number of heater element setelements.

9. A microscope slide stainer as claimed in claim 8, further comprising a temperature sensing means for providing temperature feedback data to said user interface.
10. An automated device for preparation or incubation of biologic samples, comprising:
  - a moving platform adapted to support a plurality of biologic samples;
  - a plurality of heaters positioned on the moving platform so as to provide heat to one or more samples;
  - a computer processor that specifies the desired temperatures for each the heaters, said computer processor being mounted off of the moving platform;
  - independent heating control to each of said heaters capable of heating the heaters to different temperatures, said heating control comprising:
    - a plurality of temperature controller electronic circuitry mounted on the moving platform, each supplying electrical power to at least one heater; and
    - a data communication link between the computer processor and each of said temperature controller electronic circuitry mounted on the moving platform, through which each temperature controller said electronic circuitry receives data from the computer so that each of processor to cause said temperature controller electronic circuit decodes the temperature data and circuitry to provides an appropriate amount of electrical power to each of said heaters so that each heater is heated to heat the heaters to the computer-specified processor-specified temperatures.

11. An automated device, as claimed in claim 10, wherein the biologic samples are mounted on a microscope glass slide.
12. An automated device, as claimed in claim 10, further comprising a temperature sensor that provides temperature feedback to ~~said computer~~information.
13. A microscope slide stainer ~~with random access slide staining capability,~~ comprising:
  - a moving platform adapted to support a plurality of microscope slides bearing biological samples;
  - a plurality of heating means, each for heating at least one slide, each of the heating means having the capability of heating to different temperatures;
  - ~~temperature controller~~electronic circuitry means for regulating electric power to the heating means, said ~~temperature controller~~electronic circuitry means being mounted on the moving platform; and
  - user interface means in communication with the ~~temperature controller~~electronic circuitry means for specifying a desired temperature for each microscope slide, said user interface means being mounted off of the moving platform and communicating data to the ~~temperature controller~~electronic circuitry on the moving platform to regulate the electrical power to the heating means.